

## REMARKS

### I. PRELIMINARY REMARKS

Claims 45, 47, 52, 65 and 68 have been amended. No claims have been added or canceled. Claims 45, 47, 48, 50-54, 65, 66, 68-71, 73-81, 83-87, 89, 90 and 92-101 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

On page 3, the Office Action indicates that claims 52-54 and 86 have been rejected based on the Umeda patent. Although claim 86 depends from independent claim 52, claims 53 and 54 do not. Claim 53 and 54 depend from independent claim 47, and independent claim 47 was not rejected based on the Umeda patent. Accordingly, applicant has assumed that the reference to claims 53 and 54 on page 3 was a typographical error **and that no rejection has been applied to claims 53 and 54.**

***Clarification of this issue is hereby requested.***

### II. REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

#### A. The Rejections

Claims 45, 46, 52, 79, 86 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,255,668 to Umeda ("Umeda"). Claims 75-79 and 83-85 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Umeda and U.S. Patent No. 5,507,725 to Savage ("Savage").

Claims 47, 48, 50, 51, 65, 66, 68, 80, 81, 87, 89, 90 and 98 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,554,794 to Mueller ("Mueller").

Claims 69-71, 73, 74, 92-96 and 99-101 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 6,450,948 to Matsuura ("Matsuura") and Savage.

The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed to the extent that they are applicable to the claims as amended above. Reconsideration thereof is respectfully requested.

#### **B. The Cited References**

Umeda discloses a bending device that may be used in an endoscope or catheter. Referring to Figures 1 and 2, the illustrated endoscope includes a hollow body 1, with an insertion portion 2 and a bending portion 3, and a pair of wires 8a/8b that are used to deflect the bending portion. [Column 3, lines 28-32 and 56-65.] The bending portion 3 has a bending device 9. The bending device 9 includes a thin plate 10, a coil 20, a tip member 30, a connecting tube 40 that connects the coil to the tip member, and a connecting tube 50 that connects the coil to the insertion portion 2. The connecting tubes 40 and 50 include slits 42a/42b and 51a/51b for the thin plate 10. The connecting tube 40 also includes an extra set of slits 41a/41b that allow the distal ends of the wires 8a/8b to be secured to the connecting tube 40. [Column 6, line 62 to column 7, line 7.]

Mueller discloses a variety of deflectable catheters. Referring first to Figure 7, the illustrated device includes an elongate catheter 110, a deflectable tip portion 106 and a tip 118. Turning to Figures 7A-7C, the deflectable tip portion 106 includes a pull wire lumen 103, a coil 130, and a shim 132 that are at least partially molded into the catheter material. [Column 18, lines 31-36.] The tip 118 includes a distal portion and a proximal portion that has a smaller outer diameter than the distal portion. The coil 130 extends distally past the shim to the large diameter portion of the tip 118. [Figure 7AA.]

Matsuura discloses a variety of deflectable tips for use with steerable surgical instruments. The instrument illustrated in Figures 1-5 includes a deflectable tip section 40. The deflectable tip section 40, which is referred to in the Office Action, includes proximal and distal collars 50A and 50B on opposite ends of a flexible tubular body 52. A pair of strengthening members 54 are positioned within the wall of the tubular body 52 and extend from the end collar 50A to the end collar 50B. The deflectable tip is illustrated in Figures 11

and 12 was also referred to in the Office Action. Here too, the deflectable tip includes collars 350A and 350B, a tubular body 352, and strengthening members 354A and 354B.

Savage discloses that certain structures (e.g. anchoring rings 22) may be located within a catheter wall. [Column 6, lines 16-61.]

### C. Discussion Concerning Claims 45 and 75-79

Independent claim 45 calls for a combination of elements including, *inter alia*, "an elongate body defining a proximal portion and a distal portion," "a steering wire having a distal portion," "an anchoring member" and "means, directly connected to the anchoring member, for preventing compression ..." and "a tubular member, that is a partial circle in cross-section **and includes first and second longitudinally extending edges that together define a slot in which a portion of the steering wire is located ...**" The respective combinations defined by claims 75-79 include, *inter alia*, the elements recited in claim 45.

Umeda fails to teach or suggest the claimed combinations. For example, the Office Action to have asserted that (1) one of the Umeda wires 8a/8b corresponds to the claimed "steering wire," (2) a portion of the Umeda connecting tube 50 corresponds to the claimed "tubular member," and (3) the interior passage of connecting tube 50 corresponds to the claimed "slot." [Office Action at pages 2-3.] Even assuming for the sake of argument that this was a reasonable interpretation of independent claim 45, claim 45 now indicates that the slot is "defined by first and second longitudinally extending edges." The interior passage within the Umeda connecting tube 50 is not "defined by first and second longitudinally extending edges" and, accordingly, the Umeda wires 8a/8b are not within the "slot."

As Umeda fails to teach or suggest each and every element of the combination recited in independent claim 45, applicant respectfully submits that the rejection of claims 45 and 79 under 35 U.S.C. § 102 should be withdrawn.

With respect to claims 75-78, applicant respectfully submits that Savage fails to remedy the above-identified deficiencies in Umeda. As such, the rejection of claims 75-78 under 35 U.S.C. § 103 should also be withdrawn.

#### D. Discussion Concerning Claims 47, 48, 50, 51, 66, 80 and 81

Independent claim 47 calls for a combination of elements including, *inter alia*, “an elongate body,” “a stiffening member associated with the distal portion of the elongate body and located within the elongate body wall” and “an **anti-tear device** positioned within the elongate body wall ... **adjacent to at least a portion of the proximal half of the stiffening member and not adjacent to the distal half of the stiffening member**,” and configured to prevent the stiffening member from tearing through the elongate body when the stiffening member bends.” The respective combinations defined by claims 48, 50, 51, 66, 80 and 81 include, *inter alia*, the elements recited in claim 47.

Mueller fails to teach or suggest the claimed combinations. For example, the Office Action asserted that (1) the Mueller shim 132 corresponds to the claimed “stiffening member” and (2) that the Mueller coil 130 corresponds to the claimed “anti-tear device.” [Office Action at page 5.] Even assuming for the sake of argument that this was a reasonable interpretation of independent claim 47, claim 47 now indicates that the “anti-tear device [is] not adjacent to the distal half of the stiffening member.” The Mueller coil 130, on the other hand, extends along and is adjacent to, the entire shim 132. [Figure 7 AA.]

As Mueller fails to teach or suggest each and every element of the combination recited in independent claim 47, applicant respectfully submits that the rejection of claims 47, 48, 50, 51, 66, 80 and 81 under 35 U.S.C. § 102 should be withdrawn.

#### E. Discussion Concerning Claims 52 and 83-86

Independent claim 52 calls for a combination of elements including, *inter alia*, “an elongate body,” “a steering wire,” “a stiffening member associated with the distal portion

of the elongate body" and "a substantially c-shaped anti-tear device, ***including first and second longitudinally extending edges that together define a slot***, associated with the stiffening member" Claim 52 also indicates that "***a portion of the steering wire is positioned within the slot.***" The respective combinations defined by claims 83-86 include, *inter alia*, the elements recited in claim 52.

Umeda fails to teach or suggest the claimed combinations. For example, the Office Action appears to have asserted that (1) one of the Umeda wires 8a/8b corresponds to the claimed "steering wire," (2) a portion of the Umeda connecting tube 50 corresponds to the claimed "tubular member," (3) the interior passage of connecting tube 50 corresponds to the claimed "slot." [Office Action at page 4.] Even assuming for the sake of argument that this was a reasonable interpretation of independent claim 52, claim 52 now indicates that the slot is defined by "first and second longitudinally extending edges." The interior passage within the Umeda connecting tube 50 is not defined by "first and second longitudinally extending edges" and, accordingly, the Umeda wires 8a/8b are not within the "slot."

As Umeda fails to teach or suggest each and every element of the combination recited in independent claim 52, applicant respectfully submits that the rejection of claims 52 and 86 under 35 U.S.C. § 102 should be withdrawn.

With respect to claims 83-85, applicant respectfully submits that Savage fails to remedy the above-identified deficiencies in Umeda. As such, the rejection of claims 83-85 under 35 U.S.C. § 103 should also be withdrawn.

#### **F. Discussion Concerning Claims 65 and 87**

Independent claim 65 calls for a combination of elements including, *inter alia*, "an elongate body defining a proximal portion and a distal portion and including a wall defining an inner surface, an outer surface and a lumen," "a steering wire," "a stiffening member" and "***an anti-tear device ... secured directly to the proximal end of the stiffening member*** such that the proximal end of the anti-tear device is located within the distal portion of the elongate body wall between the inner surface and the outer

surface." The combination defined by claim 87 includes, *inter alia*, the elements recited in claim 65.

Mueller fails to teach or suggest the claimed combinations. For example, the Office Action asserted that (1) the Mueller shim 132 corresponds to the claimed "stiffening member," (2) that the Mueller coil 130 corresponds to the claimed "anti-tear device" and (3) that the Mueller coil 130 is secured to the shim 132 because they are "connected via the wall material between them." [Office Action at page 7.] Even assuming for the sake of argument that this was a reasonable interpretation of independent claim 65, the Mueller coil 130 is not secured directly to the shim 132, as is now called for in claim 65. The Mueller coil 130 and shim 132 are merely molded within a common structure.

As Mueller fails to teach or suggest each and every element of the combination recited in independent claim 65, applicant respectfully submits that the rejection of claims 65 and 87 under 35 U.S.C. § 102 should be withdrawn.

#### G. Discussion Concerning Claim 68, 89 and 90

Independent claim 68 calls for a combination of elements including, *inter alia*, "an elongate body ... including a wall defining an inner surface, an outer surface and a lumen," "a stiffening member associated with the distal portion of the elongate body" and "***anti-tear means, secured directly to the proximal portion of the stiffening member*** and located within the elongate body wall." The respective combinations defined by claims 89 and 90 include, *inter alia*, the elements recited in claim 68.

Mueller fails to teach or suggest the claimed combinations. For example, the Office Action appears to have asserted that (1) the Mueller shim 132 corresponds to the claimed "stiffening member" and (2) that the Mueller coil 130 corresponds to the claimed "anti-tear device." Even assuming for the sake of argument that this was a reasonable interpretation of independent claim 68, the Mueller coil 130 is not secured directly to the shim 132, as is now called for in claim 68. The Mueller coil 130 and shim 132 are merely molded within a common structure.

As Mueller fails to teach or suggest each and every element of the combination recited in independent claim 68, applicant respectfully submits that the rejection of claims 68, 89, 90 and 98 under 35 U.S.C. § 102 should be withdrawn.

#### H. Discussion Concerning Claims 69-71, 73, 74, 92-96, 100 and 101

Independent claims 69-71 call for respective combinations of elements including, *inter alia*, "an elongate body defining ... a distal portion and including a wall defining an inner surface, an outer surface and a lumen," "a steering wire" and "an **anchoring member located within the distal portion of the elongate body wall between the inner surface and the outer surface** and secured to the steering wire." The combinations defined by claims 73, 74, 92 and 99 include, *inter alia*, the elements recited in claim 69, the combinations defined by claims 93, 94 and 100 include, *inter alia*, the elements recited in claim 70, and the combinations defined by claims 95, 96 and 101 include, *inter alia*, the elements recited in claim 71.

The Office Action failed to establish a *prima facie* case of obviousness of the claimed combinations. For example, the Office Action asserted that (1) the Matsuura distal collar 50B (or 350B), which is not located within an elongate body wall, corresponds to the claimed "anchoring member" and (2) Savage would have suggested modifications to the Matsuura device that would have resulted in the Matsuura distal collar 50B (or 350B) being moved into an elongate body wall. Applicant respectfully submits that assertion (2) is incorrect. While it is true that Savage discloses the placement of various structures within an elongate body, none of those structures define the distal end of the device, as does the Matsuura distal collar. Accordingly, Savage would not have suggested moving the Matsuura distal collar into the elongate body wall.

As illustrated above, Matsuura and Savage fail to establish a *prima facia* case of obviousness with respect to the invention defined by independent claims 69-71. The rejection of claims 69-71, 73, 74, 92-96, 100 and 101 under 35 U.S.C. § 103 should, therefore, be withdrawn.

**III. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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Date

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